

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Serial No.: 09/845,946

Confirmation No.: 3318

Filed: April 30, 2001

For: A COATED FILM LAMINATE HAVING AN IONIC SURFACE

Remarks

The Final Office Action mailed December 22, 2003 has been received and reviewed. Claim 37 having been canceled, claims 1, 10, 15, 23, 28, 32, and 35 having been amended, the pending claims are claims 1-36 and 38. Claims 10-22 having been withdrawn from consideration by the Examiner, the claims currently under examination are claims 1-9, 23-36, and 38.

Claims 1, 10, 15, 23, 28, 32, and 35 have been amended to incorporate the language of claim 37, now canceled. Claim 35 has also been amended to move the recitation that "the laminate has a projected surface area and a topographical surface area wherein the topographical surface area is greater than the projected surface area" from the preamble into the body of the claim.

Reconsideration and withdrawal of the rejections are respectfully requested.

Rejection under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 37 and 38 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully disagree.

The Examiner alleged that it is not clear where the ratios have support in the specification as originally filed. Applicants respectfully submit that claims 37 and 38 are supported by the specification at, for example, page 7, lines 1-4 (as noted on page 11, line 16 of the Amendment and Response submitted September 22, 2003).

Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §112, first paragraph.

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Allowable Subject Matter

Applicants thank the Examiner for notification to the effect that claim 25 would be allowable if rewritten in independent form. However, Applicants wish to draw the Examiner's attention to the fact that claim 25 was rewritten in independent form in the Amendment and Response submitted on September 22, 2003. Thus, Applicants again request that claim 25 be passed on to allowance.

Applicants also thank the Examiner for noting that claims 37 and 38 are not suggested by the art. The language of claim 37 having been incorporated into independent claims 1, 23, 28, 32, and 35, Applicants respectfully submit that independent claims 1, 23, 28, 32, and 35 are also patentable over the art for reasons similar to those for the patentability of claim 37 (now canceled).

Rejection under 35 U.S.C. §102

The Examiner rejected claims 1-9 and 36 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Pat. No. 6,329,113 (Bourdclais et al.). The Examiner also rejected claims 1-9, 23-24, and 26-34 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Pat. No. 6,403,278 (Fehervari et al.) with additional evidence provided by U.S. Pat. No. 5,593,809 (Kim et al.). Applicants respectfully disagree.

Applicants respectfully submit that the Examiner's reasoning supporting the rejection is not clear. In commenting on surface topography, the Examiner stated that "[t]he applicants' preamble is merely a statement of fact, not a patentable distinction" (page 4, paragraph 10 of the Office Action mailed December 22, 2003). Applicants note that independent claims 1, 23, 28, and 32 were amended in the Amendment and Response submitted September 22, 2003, to move the recitation that "the laminate has a projected surface area and a topographical surface area wherein the topographical surface area is greater than the projected surface area" from the preamble into the body of the claim. In the event that the rejection is maintained, clarification of the Examiner's reasoning supporting the rejection is respectfully requested.

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Moreover, in the interest of expediting the prosecution of the present application, claims 1, 23, 28, and 32 have been amended to recite the language of claim 37 (now canceled), and Applicants respectfully submit that the rejections have been obviated.

Reconsideration and withdrawal of the rejections under 35 U.S.C. §102 is respectfully requested.

Rejection under 35 U.S.C. §103

The Examiner rejected claim 35 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Pat. No. 6,329,113 (Bourdelaïs et al.). Applicants respectfully disagree.

However, in the interest of expediting the prosecution of the present application, claim 35 has been amended to incorporate the language of claim 37 (now canceled), and Applicants respectfully submit that the rejection has been obviated.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

Provisional Obviousness-Type Double Patenting Rejection

Claims 32-34 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Pat. Application Serial No. 09/860,944, published as US 2003/0049435 A1.

Applicants respectfully submit that the Examiner's reasoning supporting the rejection is not clear. In commenting on surface topography, the Examiner stated that "the preamble describing the topography is a statement of fact, it does not provide patentable distinction over any film" (page 5, paragraph 14 of the Office Action mailed December 22, 2003). Applicants note that independent claim 32 was amended in the Amendment and Response submitted September 22, 2003, to move the recitation that "the laminate has a projected surface area and a topographical surface area wherein the topographical surface area is greater than the projected surface area" from the preamble into the body of the claim. In the event that the rejection is

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maintained, clarification of the Examiner's reasoning supporting the rejection is respectfully requested.

Moreover, independent claim 32 having been amended to incorporate the language of claim 37 (now canceled), Applicants respectfully submit that the rejection has been obviated.

Finally, in the event that the rejection is maintained, and upon an indication of otherwise allowable subject matter, Applicants will provide an appropriate response.

Request for Rejoinder

Claims 10-22 have been withdrawn from consideration as being drawn to non-elected subject matter as a result of the Restriction Requirement mailed October 1, 2002. The non-elected claims have been amended in accordance with the currently pending claims. In view of the common language recited in the pending and withdrawn claims, Applicants respectfully request that the Examiner reconsider the Restriction Requirement, and rejoin and examine the withdrawn claims with the claims currently under examination.

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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February 23, 2004
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Commissioner for Patents, Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23rd day of February, 2004, at 12:36 p.m. (Central Time).

By: [Signature]
Name: Rachel Gagliardi-Groba